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**DEC 24 2002**

**OFFICE OF PETITIONS**

In re Application of

Wnek, et al

Application No. 09/871,324

Filed: 31 May, 2001

Attorney Docket No. 4348-000119/DVA

ON PETITION

This is a decision on the petitions filed 19 November, 2002:

- under 37 C.F.R. §1.137(a)<sup>1</sup> to revive the above-identified application (and in light of the allegation of non-receipt also considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181<sup>2</sup>); and,

<sup>1</sup> A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

(a) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(b) the petition fee required by 37 C.F.R. §1.17(l);

© A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and

(d) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action; but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

<sup>2</sup> The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

**§1.181 Petition to the Commissioner.**

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. \*\*\*

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. \*\*\*

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as

- alternatively, under 37 C.F.R. §1.137(b)<sup>3</sup> alleging unintentional delay.

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.137(b) is **GRANTED**;<sup>4</sup>
- under 37 C.F.R. §1.137(a) is **DISMISSED**; and
- as considered under 37 C.F.R. §1.181 is **DISMISSED**.

NOTE: A Power of Attorney was filed contemporaneously with the petition, however, there is no indication of the authority of the individual who signed the document, Richard Gehrin (Mr. Gehrin), to do so. If Mr. Gehrin is the authorized agent of the assignee, the record should so reflect.

As a result, the Power of Attorney has not, as of this writing, been accepted, and the Petitioner, therefore, cannot be said to have been as yet empowered to act on behalf of the applicants and/or assignee. to prosecute the instant application.

If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.<sup>5</sup>

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untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. \* \* \* (Emphasis supplied.)

<sup>3</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

<sup>4</sup> Pursuant to Petitioner's authorization, the petition fee (\$1,280.00) is charged to Deposit Account 08-0750.

<sup>5</sup> On 23 December, 2002, a telephone call was made to Ryan W. Massey (Reg. No. 38,543)--who signed the pleadings--and Michael Brennan (Reg. No. 30,612) and Stanley M. Erjavac (Reg. No. 38,442)--who are designated as Counsel under the Power of Attorney submitted contemporaneously with the instant petitions--of Harness Dickey & Pierce PLC (the Harness firm) to raise this matter with them, however, they were unavailable and a message could only be left with Mr. Erjavac's secretary alerting them to the fact that mailings from the Office would continue to go to the St. Onge firm as Counsel of Record until such time as this matter was resolved.

### BACKGROUND

The record indicates that:

- Petitioner failed to respond properly and timely to a non-final Office action mailed on 15 January, 2002, with a response due (absent extension of time) on or before 15 April, 2002;
- the application went abandoned after midnight 15 April, 2002;
- the Notice of Abandonment was mailed on 17 October, 2002;
- Petitioner alleges that responsibility for prosecution shifted in March 2002 from the firm of St. Onge Steward Johnston & Reens LLC (the St. Onge firm) to Harness Dickey & Pierce PLC (the Harness firm), however, there is no record action taken by either firm at that time to Notice the Office;
- Petitioner further alleges that an audit of reflects no effort in the records of the St. Onge firm or the Harness firm as to receipt of the 15 January, 2002, Office action, however, again, Petitioner has submitted no contemporaneous documentation (copies of file jackets, docket sheets, tickler records, etc.) in support of this allegation;
- Petitioner filed contemporaneously with the instant petitions a reply to the 15 January, 2002, Office action;
- while Petitioner requested consideration under 37 C.F.R. §1.137(b) and authorized the fee, Petitioner failed to make the express statement of unintentional delay under the regulation, nonetheless, the petition is being so interpreted and Petitioner must notify the Office if this is an incorrect reading of the petition.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>6</sup>

The regulations at 37 C.F.R. §1.137 set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally abandoned application under this congressional grant of authority .

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<sup>6</sup> 35 U.S.C. §133 provides:  
**35 U.S.C. §133 Time for prosecuting application.**  
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>7</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>8</sup>

Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>9</sup>

And Petitioner must be diligent in attending to the matter.<sup>10</sup>

Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.<sup>11</sup>

The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.<sup>12</sup> Failure to do so does not demonstrate the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>13</sup>

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<sup>7</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>8</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>9</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>10</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>11</sup> See: *In re Application of S*, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>12</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>13</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to Withdrawal  
of the Holding of Abandonment and  
Unavoidable Delay

Petitioner makes no showing in support through contemporaneous documentation of either unavoidable delay or withdrawal of the holding of abandonment.

While there may have been a lapse or mistake by Counsel's offices (either the St. Onge firm and/or the Harness firm), it in no way satisfies the Pratt showing required herein.

More than 35 years ago the Court of Customs and Patent Appeals warned practitioners in Lorenz v. Finkl<sup>14</sup> that "ordinary prudence" demands that they take "appropriate action" as directed by the Office, and practitioners disregard this warning at peril to their client's matters. (Moreover, as long as the attorney/agent has not acted to deceive the client,<sup>15</sup> the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client who hired the attorney/agent.<sup>16</sup>)

As is clear, Petitioner fails to satisfy the burdens set forth under 37 C.F.R. §1.137(a), revival based upon unavoidable delay is not appropriate, and the petition therefor hereby is **dismissed**.

The courts have determined the construct for properly supporting a request to withdraw a holding of abandonment.<sup>17</sup>

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulver. Withdrawal of the holding of abandonment is not appropriate, and the petition therefor as considered under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

Moreover, Petitioner fails to satisfy the showing in support of an allegation of unavoidable delay, and the petition under 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

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<sup>14</sup> Lorenz v. Finkl, 142 USPQ 26, 27-28 (CCPA 1964).

<sup>15</sup> When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

<sup>16</sup> The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

<sup>17</sup> See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

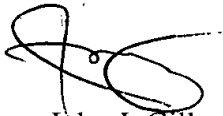
Allegation of Unintentional Delay

Petitioner has requested that the matter alternatively be considered under 37 C.F.R. §1.137(b), submitted the reply, and the statement of unintentional delay has been presumed from the request for consideration.

Therefore, the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

This matter is forwarded to Technology Center 1700 for further processing in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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